UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte EUGENE J. ROLLINS,
SAILENDRA PADALA,
NORBERT HENDRIKSE,
PAUL GAUTHIER, and
MICHAEL TSO

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Appeal 2007-0791
Application 09/747,666
Technology Center 3600

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Decided: May 22, 2007

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Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and ROBERT E. NAPPI, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants appeal from a rejection of claims 1-10, 18-27 and 35-37, which are all of the pending claims.

THE INVENTION

The Appellants claim a method, system and computer-readable medium for modifying addresses in a communications network. Claims 1 and 27 are illustrative:

> 1.   A method for modifying addresses in a communications network, the method comprising the computer-implemented steps of:
>   receiving, at an intermediary, a request for an object that is associated with a server;
>   generating, at the intermediary, a combined address that identifies both an intermediary address associated with the intermediary and an object address that is determined based on the request;
>   determining whether the combined address satisfies a particular condition; and when the combined address does not satisfy the particular condition, performing the steps of:
>   substituting at least a portion of the combined address with one or more address identifiers to create a modified combined address, wherein the modified combined address satisfies the particular condition,
>   generating, at the intermediary, a modified request that is based upon the request and that includes the modified combined address, and
>   sending the modified request to the server.

> 27.   A computer-readable medium for analyzing addresses, the computer-readable medium carrying one or more sequences of one or more

instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

      receiving a modified combined address, wherein the modified combined address is based on a combined address that does not satisfy a particular condition, wherein the modified combined address includes one or more address identifiers such that the modified combined address does satisfy the particular condition, and wherein the one or more address identifiers represents at least a portion of the combined address; and

      interpreting the one or more address identifiers based upon a mapping between the one or more address identifiers and the portion of the combined address that is represented by the one or more address identifiers.

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THE REFERENCES

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Bezos	US 6,029,141	Feb. 22, 2000
Pressler-Marshall	US 6,532,492	Mar. 11, 2003
		(filed Sep. 15, 1999)

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THE REJECTIONS

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The claims stand rejected as follows: claims 1, 3-10, 18, 20-27, and 35-37 under 35 U.S.C. § 102(e) as anticipated by Bezos, and claims 2 and 19 under 35 U.S.C. § 103 as obvious over Bezos in view of Pressler-Marshall.

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OPINION

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We reverse the aforementioned rejections and remand the application to the Examiner.

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Rejection under 35 U.S.C. § 102(e)

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We need to address only the independent claims, i.e., claims 1, 10, 18, and 35-37.

Claims 1, 18, and 35-37

Claims 1, 18, 36, and 37 require generating at an intermediary a combined address that identifies both an intermediary address associated with the intermediary and an object address, and determining whether the combined address satisfies a particular condition. Claim 35 requires a) a combined address that 1) identifies both an intermediary address associated with the intermediary and an object address that is determined based on the request, and 2) does not satisfy a particular condition, and b) an intermediary that generates a modified combined address that 1) includes one or more address identifiers that are substituted for at least a portion of the combined address and 2) satisfies the particular condition.

Bezos discloses an Internet-based customer referral service wherein entities having Web sites that provide reviews and/or recommendations on specific products sold by merchants enroll as associates through an automated registration process (col. 1, ll. 50-61). The associates' Web sites have product-specific hyperlinks to merchants' Web sites that customers can select to purchase products from the merchants (col. 1, ll. 62-66). The hyperlinks include associate identification information used by the merchants to pay commissions to the associates when customers purchase products through the associates' Web sites (col. 1, l. 66 – col. 2, l. 18).

The Examiner argues that Bezos' associate's address corresponds to the Appellants' combined address and does not satisfy a particular condition of allowing a product to be purchased, and that Bezos' merchant's address corresponds to the Appellants' modified combined address and satisfies the

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particular condition by allowing the product to be purchased (Answer 7-8). Bezos' associate's address, however, is not generated at the associate and does not identify the requested object's address. Thus, Bezos' associate's address cannot correspond to the Appellants' combined address.

The examiner, therefore, has not established a prima facie case of anticipation of the inventions claimed in the Appellants' claims 1, 3-10, 18, 20-27, and 35-37.

<div align="center">Claims 10 and 27</div>

Claims 10 and 27 require receiving a modified combined address that is based on a combined address that does not satisfy a particular condition and includes one or more address identifiers such that the modified combined address does satisfy the particular condition, wherein the one or more address identifiers represent at least a portion of the combined address.

The Appellants argue that in Bezos, "a modified combined address is not based on a combined address that does not satisfy a particular condition. In contrast, according to Bezos, the user may selects [sic, select a] fixed, predetermined URL to navigate to an entirely new web page" (Reply Br. 5).

The Examiner argues that "[w]hen the user is taken from the intermediary website or URL ('141, figures 5 and 6) to the merchant's website or URL ('141, figures 5 and 8) the user is receiving a *modified combined address, wherein the modified combined address is based on a combined address that does not satisfy a particular condition* where the condition that is not satisfied by the combined address is the ability to purchase the book" (Answer 8).

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The Examiner asserts that Bezos' modified combined address (merchant's address) is based upon the combined address (associate's address), but the Examiner has not explained, and it is not apparent, why that is so.

We therefore find that the Examiner has not carried the burden of establishing a prima facie case of anticipation of the inventions claimed in the Appellants' claims 10 and 27.

<div align="center">Rejection under 35 U.S.C. § 103</div>

The Examiner does not rely upon Pressler-Marshall for any teaching regarding the above-discussed deficiencies in Bezos as to claims 36 and 37 from which claims 2 and 19, respectively, depend (Answer 5-6). The Examiner, therefore, has not established a prima facie case of obviousness of the inventions claimed in the Appellants' claims 2 and 19.

<div align="center">Remand</div>

To be patentable subject matter under 35 U.S.C. § 101, an invention must produce a useful, concrete and tangible result. *See State Street Bank & Trust v. Signature Financial Group*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998). The Appellants' claims 10 and 27 require only receiving a modified combined address including one or more address identifiers, and interpreting the one or more address identifiers. Thus, the inventions as claimed do not appear to produce a useful, concrete and tangible result. We therefore remand the application for the Examiner and the Appellants to address on the record whether the inventions claimed in claims 10 and 27, as well as the other claims, produce a useful, concrete and tangible result as required by 35 U.S.C. § 101.

DECISION

The rejections of claims 1, 3-10, 18, 20-27 and 35-37 under

35 U.S.C. § 102(e) over Bezos, claims 2 and 19 under 35 U.S.C. § 103 over Bezos

in view of Pressler-Marshall, are reversed. The application is remanded to the

Examiner.

REVERSED and REMANDED

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